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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,841	08/08/2003	William Delaplaine Green		3345

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EXAMINER

ALI, HYDER

ART UNIT	PAPER NUMBER
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3747

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/637,841

Applicant(s)

GREEN, WILLIAM DELAPLAINE

Examiner

HYDER ALI

Art Unit

3747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-41, 64 and 65 is/are allowed.
- 6) ☒ Claim(s) 42-56, 58 and 60-63 is/are rejected.
- 7) ☒ Claim(s) 57 and 59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/19/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 42-56,58,60-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6546901. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6546901 discloses an internal combustion engine comprising compressor means and reciprocating means no different from the matters described in claims 42-56,58,60-63 of present application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42-56,58,60-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowells (US 5,634,447).

As to Claim 42, Rowells discloses a internal combustion engine 10 having housing means, compressor means 34, reciprocating means 28, and fuel supply means 25, to cause combustion of said fuel between said compressor means 34 and said reciprocating means 28 wherein said compressor means 34 and said reciprocating means 28 receive a power transfer from said combustion.

As to Claim 43, Rowells discloses fuel injection means 25.

As to Claim 44, Rowells discloses ignition means by compression.

As to Claim 45, Rowells discloses cooling means (not numbered).

As to Claim 46, Rowells discloses lubrication means (inherent).

As to Claim 47, Rowells discloses cylinder means 26.

As to Claim 48, Rowells discloses piston means 28.

As to Claim 49, Rowells discloses camshaft means (inherent).

As to Claim 50, Rowells discloses valve means 30.

As to Claim 51, Rowells discloses throttle means (inherently located in the intake manifold 19).

As to Claim 52, Rowells discloses crankshaft means 21.

As to Claim 53, Rowells discloses a method for internal combustion engine, which comprises: compressing a fuel within a housing means between a compressor means 34 and a reciprocating means 28 to cause combustion wherein the energy of

combustion is transferred to said reciprocating means 28 and said compressor means 34.

As to Claim 54, Rowells discloses said compressor means 34 is rotationally connected to said reciprocating means 28.

As to Claim 55, Rowells discloses fuel injection means 25 injects fuel into said housing means.

As to Claim 56, Rowells discloses a method for a internal combustion engine 10, which comprises: compressing a fuel within a housing means between a compressor means 34 and a reciprocating means 28 wherein the energy of combustion is transferred to said reciprocating means 28 and said compressor means 34.

As to Claim 58, Rowells discloses apparatus for a internal combustion engine 10, which comprises housing means; compressor means 34; reciprocating means 28; fuel supply means 25; means to compress fuel between said compressor means 34 and said reciprocating means 28 to initiate combustion, wherein the power of combustion is transferred to said reciprocating means 28 and said compressor means 34.

As to Claim 60, Rowells discloses cooling means (not numbered).

As to Claim 61, Rowells discloses lubrication means (inherent).

As to Claim 62, Rowells discloses valve means 30.

As to Claim 63, Rowells discloses bearing means (inherent to support crankshaft 21).

Allowable Subject Matter

Claims 1-41,64 and 65 are allowed.

Claims 57 and 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-65 have been considered but are moot in view of the new ground(s) of rejection. Rowells discloses when the intake valve is closed the energy of combustion is transferred to reciprocating means 28 and when the exhaust valve 30 opens the energy of combustion is transferred to compressor means 34.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HYDER ALI whose telephone number is (571) 272-4836. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HENRY YUEN can be reached on (571) 272-4856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3747

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Hyder Ali". The signature is fluid and cursive, with the first name "Hyder" and the last name "Ali" clearly distinguishable.

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